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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,849	07/24/2001	Nobuyuki Kobayashi	P21228	4815
7055	7590	03/11/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			SELLERS, DANIEL R	
			ART UNIT	PAPER NUMBER
			2644	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/910,849	KOBAYASHI ET AL.	
	Examiner	Art Unit	
	Daniel R. Sellers	2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>see attachment</u> . | 6) <input type="checkbox"/> Other: _____ |

10/24/01

11/03/03

03/17/04

DETAILED ACTION

Claim Objections

1. Claim 4 is objected to because of the following informalities: On page 31, line 17 of the application “ ... and records the recording data recorded in said internal memory, in the mounted external memory when....” there is an unnecessary comma between the word “memory” and the word “in”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The limitation “... when the external memory is removed and mounted during recording....” is unclear as to how an external memory is both to be removed and mounted at the same time, or sequentially. The office interprets this phrase to “... removed or mounted....”

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 5, and 8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Tanaka et al., U.S. Patent No. 6,446,177 (hereinafter Tanaka).

6. Regarding claim 1, see Tanaka,

A digital recording and reproducing apparatus which is capable of having a removable external memory mounted therein, for performing recording of recording data in the external memory and reproduction based on the recording data recorded in the external memory, the digital recording and reproducing apparatus comprising:

an identification data-generating block for generating identification data for identifying the external memory individually; (Col. 8, lines 21-29)

an internal memory in which the identification data can be recorded; and (Col. 2, lines 66-67).

a control block for recording the identification data in the external memory and said internal memory, and carrying out identification data determination processing for determining, when mounting of the external memory is detected, whether or not the identification data recorded in the external memory and the identification data recorded in said internal memory are identical to each other. (Col. 2, line 55 – Col. 3, line 2).

Tanaka teaches these features.

7. Regarding claim 2, the further limitation of claim 1, see Tanaka,

... wherein said control block records the identification data in both of the external memory and said internal memory before the recording data is recorded in the external memory. (Col. 7, lines 18-23).

Tanaka teaches this feature.

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8. Regarding claim 5, the further limitation of claim 1, see the preceding argument with respect to claim 1. Tanaka teaches that the identification data-generating block generates random numerical data.

9. Regarding claim 8, the further limitation of claim 2, see the preceding argument with respect to claims 2 and 5. Tanaka teaches the features of claims 2 and 5.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3, 4, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka as applied to claim 2 above, and further in view of Kubo, U.S. Patent No. 6,631,427.

12. Regarding claim 3, the further limitation of claim 2, see Tanaka,

... wherein said control block carries out the identification data determination processing when the external memory is removed and mounted during recording of the recording data in the external memory, said control block continuing to record the recording data in the mounted external memory when the identification data recorded in the external memory and the identification data recorded in said internal memory are identical to each other, and carrying out predetermined error-handling processing when the identification data recorded in the external memory and the identification data recorded in said internal memory are different from each other. (Col. 2, line 63 – Col. 3, line 2).

Tanaka teaches the predetermined error-handling in a memory system. Tanaka teaches that the identification data is compared to determine whether or not the data can be used. Tanaka does not teach the step of recording the data to the memory

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system. Kubo teaches the recording of digital data to a memory device (Col. 1, lines 41-53). Kubo teaches that the discriminating means decide whether or not recording can be done on the memory. It would have been obvious for one of ordinary skill in the art to combine the teachings of Tanaka and Kubo for the purpose of creating a protected removable data system.

13. Regarding claim 4, the further limitation of claim 2,

... wherein said control block causes the recording data to be recorded in said internal memory when the external memory is removed during recording of the recording data in the external memory, carries out the identification data determination processing when the external memory is mounted, and records the recording data recorded in said internal memory, in the mounted external memory when the identification data recorded in the external memory and the identification data recorded in said internal memory are identical to each other.

Tanaka teaches the features of claim 2, and teaches the identification data determination processing when the external memory is mounted. Tanaka does not teach the recording of data to an internal memory. Kubo teaches that the recording process records to the internal memory when the external memory is removed during recording (Col. 1, lines 32-38 and lines 49-53). Kubo teaches that the recorded data in the internal memory is recorded to the external memory (Col. 6, lines 40-45).

14. Regarding claim 9, the further limitation of claim 3, see the preceding argument with respect to claims 3 and 5. The combination of Tanaka and Kubo teach these features.

15. Regarding claim 10, the further limitation of claim 4, see the preceding argument with respect to claims 4 and 5. The combination of Tanaka and Kubo teach these features.

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16. Claims 6, 7, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka as applied to claims 1 and 5 above, and further in view of Pawlowski et al., U.S. Patent No. 6,038,199 (hereinafter Pawlowski).

17. Regarding claim 6, the further limitation of claim 1,

... wherein the recording data is sound data, and wherein the digital recording and reproducing apparatus includes a sound signal input block for inputting an analog sound signal, a sound data generation block for generating the sound data by converting the analog sound signal to digital data and compressing the digital data, a sound signal generation block for decompressing the sound data recorded in the external memory to generate the digital data and converting the digital data to the analog sound signal, and an amplifier circuit for amplifying the converted analog sound signal to output the amplified sound signal.

Tanaka teaches the features of claim 1, however Tanaka does not teach the sound processing blocks as described by these limitations. Pawlowski teaches a portable digital audio recorder. The device has the sound signal input block (Fig. 3, unit 56), the sound data generation block, and the sound signal generation block (Fig. 3, units 52 and 54) for outputting an amplified signal (Fig. 3, unit 58) from an external memory (Fig. 3, unit 64). It would have been obvious for one of ordinary skill in the art to combine the teachings of Tanaka and Pawlowski for the purpose of creating protected audio works.

18. Regarding claim 7, the further limitation of claim 5, see the preceding argument with respect to claim 6. Tanaka teaches the features of claim 5, and therefore the combination of Tanaka and Pawlowski teach the features of claim 7.

19. Regarding claim 11, the further limitation of claim 2, see the preceding argument with respect to claims 2 and 6. The combination of Tanaka and Pawlowski teach these features.

20. Regarding claim 14, the further limitation of claim 8, see the preceding argument with respect to claims 6 and 8. The combination of Tanaka and Pawlowski teach these features.

21. Claims 12, 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tanaka and Kubo as applied to claim 3 above, and further in view of Pawlowski.

22. Regarding claim 12, the further limitation of claim 3, see the preceding argument with respect to claims 3 and 6. The combination of Tanaka and Kubo teach the features of claim 3, however they do not teach the sound processing blocks as described by these limitations. Pawlowski teaches a portable digital audio device with these features. It would have been obvious for one of ordinary skill in the art to combine the teachings of Pawlowski with the combination of Tanaka and Kubo for the purpose of creating protected audio works.

23. Regarding claim 13, the further limitation of claim 4, see the preceding argument with respect to claims 4 and 6. The combination of Tanaka, Kubo, and Pawlowski teach these features.

24. Regarding claim 15, the further limitation of claim 9, see the preceding argument with respect to claims 6 and 9. The combination of Tanaka, Kubo, and Pawlowski teach these features.

25. Regarding claim 16, the further limitation of claim 10, see the preceding argument with respect to claims 6 and 10. The combination of Tanaka, Kubo, and Pawlowski teach these features.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel R. Sellers whose telephone number is 703-605-4300. The examiner can normally be reached Monday to Friday from 9am to 6:30pm with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 703-305-4040. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SINH TRAN
SUPERVISORY PATENT EXAMINER

DRS